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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/722,019	11/24/2003	Jeffrey C. Felt	32355.12.1.3.2	6543
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INTELLECTUAL PROPERTY GROUP FREDRIKSON & BYRON, P.A. 200 SOUTH SIXTH STREET SUITE 4000 MINNEAPOLIS, MN 55402			EXAMINER ROBERT, EDUARDO C	
			ART UNIT	PAPER NUMBER
			3732	

DATE MAILED: 08/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/722,019	<b>Applicant(s)</b> FELT ET AL.	
	<b>Examiner</b> Eduardo C. Robert	<b>Art Unit</b> 3732	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 2/4/05 & 5/27/05.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 31-56 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 31-56 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 November 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>12/27/04</u> . | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION*****Election/Restrictions***

Applicant's election with traverse of Species I (Figures 1a-1b) on February 4, 2005 and May 27, 2005 is acknowledged. The traversal is on the ground(s) that the Office fails to meet either of the two fundamental requirements of any restriction requirement 1) reasons why the inventions as claimed are either independent or distinct, and 2) reasons for insisting on restriction. This is not found persuasive because the examiner has clearly stated that the application contains "distinct species" and listed 14 different embodiments of species with reference to the Figures, thus showing by this means that the species are distinct (see Election mailed on November 2, 2004). Moreover, the examiner stated in the Election mailed on November 2, 2004 that if applicants believe the species were not patentably distinct, they should submit evidence or identify such evidence showing the species to be obvious variants or clearly admit on the record that this is the case. In the instant case, applicants have not even tried to argue that the species are not patentably distinct. This is considered by the examiner as an inherent admission by applicants that the species are distinct. With regard for insisting on restriction, it is noted that the searching of 14 different species would be extremely burdensome in the examiner. With regard applicant statement that "a reasonable number of species may be included in a single application", it is noted that the examiner is of the opinion that 14 distinct species are not "reasonable".

It is acknowledged that applicants believe all the claims are readable on the elected Species I, i.e. Figures 1a-1b, and that claim 1 is a generic claim. The examiner agrees with applicant.

The requirement is still deemed proper and is therefore made FINAL.

### *Drawings*

The drawings are objected to because Figures 1, 2, 3, 4, 5, 6, 7, 8, 9, 11, 12, and 13 are not present in the drawings, however, the specification make reference to them. Figure 3a appears to contain 3 different figures, and thus each figure should be labeled separately. Figure 3b appears to contain 3 different figures, and thus each figure should be labeled separately. Figure 3c appears to contain 3 different figures, and thus each figure should be labeled separately. Figures 6c appears to contain 3 different figures, and thus each figure should be labeled separately. Figures 12a, 12b, 12c, 12d, and 12e need the label "Figure" or "Fig.". Figures 12a, 12b, 12c, 12d, 12e, 13a, and 13b contain extraneous matter, e.g. "SIDE PLANE VIEW", "SECTION VIEW", "FRONT PLAN VIEW", etc., which is not permitted and should be removed. Correction is required.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes

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made to the brief description of the several views of the drawings for consistency.

Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### *Specification*

The disclosure is objected to because of the following informalities: there is no brief description for Figures 1a, 1b, 2a, 2b, 3a, 3b, 3c, 4a, 4b, 5a, 5b, 6a, 6b, 6c, 6d, 7a, 7b, 7c, 7d, 8a, 8b, 8c, 9a, 9b, 9c, 11a, 11b, 11c, 11d, 12a, 12b, 12c, 12d, 12e, 13a, and 13b. Appropriate correction is required.

Also, the continuing data at the beginning of the specification should be updated to reflect the current status of each application. Moreover, in line 3, "The present application is a divisional" should be changed to a -- The present application is a continuation -- since in the Inventions elected for prosecution in the parent application and in this application are the same, i.e. Species I directed to the embodiments of Figures 1a-1b. Thus, clearly this application is a continuation and not a divisional and will be treated as such for examination purposes.

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### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 31-56 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-15 of U.S. Patent No. 6,652,587. Although the conflicting claims are not identical, they are not patentably distinct from each other because the difference between the application claims and the patent claims lies in the fact that the patent claims include more elements and are thus much specific. Thus the invention of the patent claims are in effect a "species" of the "generic" invention of the application claims. It has been held that the generic invention is "anticipated" by the "species". See *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993). Since the application claims are anticipated by the patent claims, they are not patentably distinct from the patent claims.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 31-33, 45, 47-49, and 52-54 are rejected under 35 U.S.C. 102(b) as being anticipated by Averill et al. (U.S. 3,728,742, cited by applicant).

Averill et al. disclose a system comprising a knee implant 16 having a kidney shape (see Figure 6) and also having a first major surface, including an indentation (see Figure 6), adapted to be positioned upon a tibia plateau (see Figure 2) and a second major surface having the ability to be positioned against a femoral condyle 17, 18 (see Figures 1-4). The second surface having a femoral glide path formed by central depressions for receiving the femoral condyle 17, 18. The implant further comprises one or more tibia projections, e.g. 32, 30, 31 (see Figures 1-4). As shown in Figure 2, the projections 32 extend distally over a rim of the tibia plateau. The implant includes a posterior lip. The second surface has a concave shape (see Figure 3). The implant 16 can be made from a metal, polymer or ceramic (see col. 2, lines 42-44). With regard the statement of intended use and other functional statements, it is noted that the law of anticipation does not require that the reference “teach” what the subject patent teaches, but rather it is only necessary that the claims under attack “read on” something in the reference. *Kalman v. Kimberly Clark Corp.*, 218 USPQ 781 (CCPA 1983). Furthermore, **the manner in which a device is intended to be employed does not differentiate the claimed apparatus from prior art apparatus satisfying the claimed structural limitations.** *Ex parte Masham*, 2 USPQ2d 1647 (1987).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 34-37, 39-44, 46, 55, and 56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Averill et al. (U.S. Patent No. 3,728,742, cited by applicant).

Averill et al. disclose the claimed invention except for the ranges set forth in the claims 34-37 and 39-44. It would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the implant of Averill et al. having different ranges, as set forth in the claims 34-37 and 39-44, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233. With regard to claims 45, 55, and 56, it would have been an obvious matter of design choice to one skilled in the art at the time the invention was made to construct the implant of Averill et al. with the first surface having a convex shape, since it is anything more than one of numerous shapes or configurations a person ordinary skill in the art would find obvious for the purpose of providing a shape that match to the tibia plateau. In re Dailey and Eilers, 149 USPQ 47 (1966).




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***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eduardo C. Robert whose telephone number is 571-272-4719. The examiner can normally be reached on Monday-Friday, 9:30am-6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo C. Robert can be reached on 571-272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Eduardo C. Robert  
Primary Examiner  
Art Unit 3732

E.C.R.